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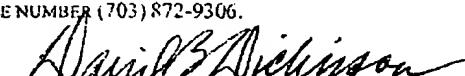
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In re Application of: REN ET AL

§ Confirmation No.: 5019

§

§ Group Art Unit: 2172

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§ Examiner: TRUONG, CAM Y T

§

§ Attorney Docket: REN,01B

§

§ Date: April 14, 2005

§

For: ADVANCED METHOD AND  
SYSTEM OF AUTOMATIC  
POPULATION AND  
MAINTENANCE OF A WEB-  
BASED DATABASE

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir or Madam:

Applicant files this Appeal Brief pursuant to 37 C.F.R. §1.192. Please charge deposit account 501285/DBD/REN-01 in the amount of \$250.00 for the fee for filing the Appeal Brief and any other fees that may be associated with this communication. The Notice of Appeal was filed on or about February 14, 2005.

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Please find enclosed the following sections:

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### **1. REAL PARTY IN INTEREST**

This application has been assigned to AEC SOFTWARE USA, INC., a Texas corporation with an address at 5433 Westheimer Road, Suite 730, Houston, Texas 77056. The assignment was recorded on April 12, 2001 at Reel 011704, Frame 0182.

### **2. RELATED APPEALS AND INTERFERENCES**

Applicant is not aware of any other appeals or interferences which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

### **3. STATUS OF CLAIMS**

Claims 1-12 and 17-23 are pending in the application. Claims 1-12 and 17-23 were rejected under the following 35 USC 103(a) rejections:

- Claims 1-3, 7, 9, 11, 12 and 17 were rejected as being unpatentable over *Anderson et al* (USPN 6144959) in view of *Robertson* (USPN 6269369);
- Claims 4-6 were rejected as being unpatentable over *Anderson et al* in view of *Robertson* and further in view of *Reilly* (USPN 6427164);
- Claims 8 and 20 were rejected as being unpatentable over *Anderson et al* in view of *Robertson* and further in view of *Trent et al* (USPN 5961620);

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- Claims 10, 22 and 23 were rejected as being unpatentable over *Anderson et al* in view of *Robertson* and further in view of *Trent et al* and *Despres et al* (USPN 6434379);
- Claims 18, 19 and 21 were rejected as being unpatentable over *Anderson et al* in view of *Robertson* and further in view of *Lee et al* (USPN 6108691);
- Claims 1, 7 and 17 were rejected as being unpatentable over *Anderson et al* in view of *Johnson et al* (USPN 5664109);
- Claims 2-6 were rejected as being unpatentable over *Anderson et al* in view of *Johnson*;
- Claims 9, 11 and 12 were rejected as being unpatentable over *Anderson et al* in view of *Johnson* and further in view of *Robertson*;
- Claims 8 and 20 were rejected as being unpatentable over *Anderson et al* in view of *Johnson et al* and further in view of *Trent*;
- Claims 18, 19 and 21 were rejected as being unpatentable over *Anderson et al* in view of *Johnson* and further in view of *Lee*; and
- Claims 10, 22 and 23 were rejected as being unpatentable over *Anderson et al* in view of *Johnson* and further in view of *Trent* and *Despres et al*.

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All claims were at least rejected as being unpatentable over *Anderson* in view of *Robertson* or *Johnson*.

Applicant appeals the rejection of claims 1-12 and 17-23 under 35 U.S.C. 103(a) as being unpatentable over *Anderson* '959 in view of *Robertson* '369 or *Johnson* '109, as stated in the Final Office Action of September 13, 2004.

#### **4. STATUS OF AMENDMENTS**

No amendments have been filed in this application since the final rejection of September 13, 2004. All previously filed amendments have been entered.

#### **5. SUMMARY OF INVENTION**

The present invention provides an advanced method and system of automatic population and maintenance of a web-based database 32. The system consists of receiving records of individuals from an existing database 10 into a web-based database 32 without requiring the individuals to register. The system then creates a temporary access account 40 for each individual record and transmits the access account 40 to the non-registered individuals 60. This allows the individuals to access the web-based database 32 to verify and update their records. The system has an auto-updater 130 to automatically update the records in the existing database 10 from the updated records in the web-based database 32. This novel process allows organizations to maintain their customer databases more efficiently and ensures the information in the database is generally more current

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than it would be without this novel method of managing the database. This novel method is a major improvement over the prior art method of waiting for correspondence to be returned and updating the record based on the returned correspondence.

## 6. ISSUES

1. Whether the examiner ever properly considered the June 1, 2004 Amendment to Claim 17.
2. Whether U.S. Patent 6,144,959 to Anderson et al. is an appropriate primary reference for establishing *prima facie* obviousness where the reference fails to teach the limitations cited by the examiner.
3. Whether U.S. Patent 6,144,959 to *Anderson* et al. in view of U.S. Patent 6,269,369 to *Robertson* or U.S. Patent 5,664,109 to *Johnson* teaches the limitation "receiving records of individuals from an existing database automatically and without registration by the individuals; populating a web-based database with the individual records of the non-registered individual".
4. Whether U.S. Patent 6,144,959 to *Anderson* et al. in view of U.S. Patent 6,269,369 to *Robertson* or U.S. Patent 5,664,109 to *Johnson* teaches the

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limitation "a database automatically populated with existing customer data records without registration by the customer."<sup>1</sup>

Applicant respectfully submits that the examiner did not properly consider the June 1, 2004 Amendment to Claim 17. Further, the references relied upon by the examiner do not teach the limitation and taken with the other art of record do not support even a *prima facie* case of obviousness because the examiner fails to establish some objective teaching in the prior art that would lead one to combine the relevant teachings of the references. Lacking any showing of motivation to combine, the examiner's rejection of the claims should be overturned.

## 7. GROUPING OF THE CLAIMS

The claims can be grouped as follows:

Group 1: Claims 1-12, directed toward a method of automatically populating, maintaining, and updating a web-based database without requiring prior registration. Claim 1 is representative of the appealed claims of Group 1.

Group 2: Claims 17-23, directed toward a remotely accessible data storage system containing the necessary components to perform the method described in the claims of Group 1. Claim 17 is representative of the appealed claims of Group 2.

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<sup>1</sup> Although examiner failed to consider the as-amended claim. Applicant will only discuss the patentability of Claim 17 as amended on June 1, 2004.

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## 8. ARGUMENT

### Introduction

To reject claims for obviousness, the prior art must (1) create a *prima facie* case of obviousness (2) which is unrebutted by Applicant. *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ 2d 1453, 1455 (Fed. Cir. 1998). To establish a *prima facie* case of obviousness, three basic criteria must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; (3) the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (cited in MPEP 2143). *See also* MPEP 2142-2143.03. Normally, references from the same field of endeavor should be sought. Applicant would contend that a pertinent field of endeavor to gauge the prior art references and the level of skill in the art relates to commercial database design and implementation, while the examiner clearly believes anything in the data processing field is relevant. Clearly, the applicant's conception of the invention at hand is vastly different than the image the examiner gratuitously asserts by her rejections. Applicant respectfully

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submits that the prior art references relied on by the examiner failed to establish a *prima facie* case of obviousness with respect to the claims of Groups 1 or 2.

The examiner cobbled together her rejection<sup>2</sup> of the claims with a new reference previously not used (Anderson et al., U.S. Patent No. 6,441,959) making the first office action after this reference final contending Applicant made the new search necessary because of its amendment. Though the examiner contends that applicant's amendment made the addition of *Anderson* necessary, the examiner readily admits that *Anderson* does not teach the language actually amended by applicant.

The examiner relies principally on the *Anderson* reference in combination with either *Robertson* '369 or *Johnson* '109 in rejecting the two independent claims 1 and 17. The examiner readily admits that *Anderson* does not teach the limitation "receiving records of individuals from an existing database automatically and without registration by the individuals; populating a web-based database with the individual records of the non-registered individual" as required by Claim 1. **Office Action**

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<sup>2</sup> The examiner's careless incorporation of text from the December 29, 2003 Office Action into the September 13, 2004 office action makes response to this action difficult. Examples of these misplaced text fragments are scattered throughout the September 13, 2004 Office Action. Only one such example is explained herein. The bottom paragraph on Page 12 of the September 13, 2004 Office Action begins exactly as the first paragraph on page 15 of the December 29, 2003 Office Action, including a reference not relied upon in the latter office action and the same grammatical mistakes. The same error occurs in the paragraph immediately following. The paragraphs are identical with the exception of the word "however" inserted in each paragraph of the latter office action. The examiner presumably intended to substitute "Anderson" for "Lee" in these paragraphs, but failed to do so. Errors such as this are numerous and make it very difficult for applicant to determine examiner's exact position.

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**dated September 13, 2004** at 2-3 and 16. The examiner further admits that *Anderson* '959 does not teach the limitation "a database automatically populated with existing customer data records without action taken by the customer" as required by Claim 17 prior to the June 1, 2004 amendment. **Office Action dated September 13, 2004** at 7 and 17. The examiner nevertheless maintains that either *Robertson* '369 or *Johnson* '109 teaches the claimed limitations and can be combined to create a *prima facie* obviousness rejection. The examiner's interpretation of the above references is incorrect and all rejected claims should be allowed.

**Prior Art Reference: Anderson '959**

The major reference relied upon by the examiner in making the rejection based on obviousness, *Anderson*, discloses a system and method for managing user accounts in a distributed communications network. *Anderson* describes automatically creating a user account on a new workstation for an individual who has an account on the network server, but not previously from that specific workstation. [col. 8, lines 1-10]. *Anderson*'s invention will not work for non-registered individuals because *Anderson* will only function with individuals that have a pre-registered account to access the server. [col. 7, lines 38-47; col 9, lines 44-56]. Inherent in this disclosure is the fact that this domain account must be pre-registered by a systems administrator prior to the login. *Anderson* specifically discloses that the "user information is maintained in the directory services

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database" and "the system allows a user to roam to different workstations and access the same user accounts and workstation properties" [col. 4, lines 31-35]. Examiner readily admits that *Anderson* does not disclose all of the claimed limitations in Group 1 or Group 2. **Office Action dated September 13, 2004** at 2-3, 7, 16-17. For purposes of this appeal, it is not necessary for applicant to present argument regarding *Anderson* because neither *Robertson* nor *Johnson* properly teach the limitations the examiner admitted are not taught by *Anderson*.

**Prior Art Reference: Robertson '369**

*Robertson* '369 describes a personal contact system designed for the purpose of "creating links between *members* (*i.e.* *registered individuals*) over a network and providing information to each member based on levels of permission maintained by the other members to which they are linked." [col. 1, lines 7-10]. Furthermore, *Robertson*'s invention "is based on a relational database scalable to millions of users that resides on a server computer." [col. 2, lines 51-52]. The relational "database 340 contains contact information entered by *registered users*." [col. 4, lines 42-43]. It is clear that *Robertson*'s personal contact system requires users to *register* to become *members* of the system and only then can their address book (database) be populated with the information of other *registered individuals*.

In addition, the receipt of the records of the *registered individuals* into each personal address book (database) is not automatic. Rather a first individual must

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request that the records of a *registered individual* be added to the first individual's personal address book (database). [col. 7, lines 56-60; col. 8, lines 14-29]. The *registered individual's* information will only be added to the first individual's registered address book if the *registered individual grants the appropriate permission.* [col. 8, lines 14-29]. "Which categories of each second user's information are displayed in the first user's personal address book is controlled completely by the second user". [col. 10, lines 10-12]. The permissions are further governed by a set of "permission rules". [col. 8-9, lines 60-49].

The conclusion reached by the examiner that it would have been obvious to a person of an ordinary skill in the art at the time of the invention was made "to apply Robertson's teaching of each first user, the present invention maintains a database of information about the second users to whom the first user has established a link (Office Action of September 13, 2004)" does not satisfy the "clear and particular" showing of motivation to combine the references required. *In re Dembiczaik*, 175 F. 3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

#### Prior Art Reference Johnson '109

*Johnson '109* describes a medical network of computer servers wherein the server computers "store medical record documents and data for each [registered] patient of each subscribing [registered] provider." [col. 4, lines 54-55]. The invention described by *Johnson* requires that any records are from an individual

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that has previously registered for storing their record. For example, a patient registers with a medical service provider that has already registered with the entity providing the medical record storage services. This involves at least two distinct registration steps in order to store the medical information. Johnson further emphasizes the registration requirement in disclosing a “database is automatically populated using information extracted from certain documents such as an admission or *registration* document” [col. 3, lines 18-20] and describing the use of “registration documents” for “new patients” [col. 12, lines 44-45]. The medical record database taught by Johnson specifically requires registration and thus teaches away from Applicant’s invention.

*Johnson* further discloses that the invention includes “at least one network of server computers 112 organized as a local area network for serving a plurality of subscriber client systems.” [col. 4, lines 47-49]. *Johnson* further requires that “subscribing providers submit all medical records for their patients.” [col. 4, lines 61-62]. Only after the “subscribing providers submit all medical records for their patients” can the system described by *Johnson* “automatically [extract] data from documents [and] populate data bases with information extracted from documents.” [col. 5, lines 9-10].

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**The Examiner failed to establish *prima facie* obviousness**

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The examiner finds some limitations of the claims of Group 1 and Group 2 in *Anderson*, but readily admits that *Anderson* does not teach or suggest “receiving records of individuals from an existing database automatically and without registration by the individuals; populating a web-based database with the individual records of the non-registered individual” or “without action taken by the customer”. **Office Action dated September 13, 2004** at 2-3, 7, 16-17. The examiner relies on *Robertson* or *Johnson* to teach the additional limitation required for each claim group. Neither of these prior art references bridges the gap between *Anderson* and Applicant’s claimed invention, nor demonstrate any motivation to combine with *Anderson*.

Even if, assuming *arguendo*, *Anderson* in view of *Robertson* or *Johnson* is capable of rendering Applicant’s invention obvious when combined, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Even if *Robertson* or *Johnson* taught the limitation “without registration” (which they don’t), both *Robertson* and *Johnson* teach away from their combination with *Anderson* to

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supply the "without registration" limitation because Anderson clearly requires registration. [col. 7, lines 38-47; col 9, lines 44-56].

Furthermore, it is improper to modify references where the modifications proposed renders the prior art references unsatisfactory for their intended purpose, and there is no suggestion or motivation to make the proposed modifications. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The examiners proposed modifications requiring *Anderson*, *Robertson*, and *Johnson* to function "automatically and without registration" and "without action taken by the customer" renders each reference unsatisfactory for its intended purpose, and thus there is no suggestion or motivation to make the proposed modifications. Each reference requires the user to be previously "registered".

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. [FN15] This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

*In re Fritch*, 972 F.2d 1260, 1266, 23 PQ2d 1780, 1784 (Fed. Cir. 1992).

Additionally, because the modifications to each reference proposed by the examiner would change the principle of operation of the prior art inventions being modified, the teachings of the references are likewise insufficient to render the claims *prima facie* obvious on this ground. *In re Ratti*, 270 F.2d 819, 123 USPQ

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349 (CCPA 1959). The examiner's proposed combinations are incapable of rendering the claims of Group 1 or Group 2 obvious because there is no suggestion or motivation to combine either *Robertson* or *Johnson* with *Anderson*.

**Claim 17 and the Claims of Group 2 were rejected without proper examination**

The examiner improperly rejected Claim 17 and the remaining dependent claims of Group 2 without proper examination. In the final **Office Action dated September 13, 2004**, examiner utilized claim language that had been previously amended in the amendment dated June 1, 2004 in response to the office action dated December 29, 2003. In the June 1, 2004 Amendment, Applicant amended claim 17 to replace the term "action taken" with "registration" in the first limitation of the claim. Applicant also added the limitation "unregistered" before "customer" in the third limitation. *See Amendment dated June 1, 2004* at 4. These amendments were proper and entered by the examiner, yet the examiner apparently failed to utilize the correct claim language in his final rejection of September 13, 2004. This is especially egregious considering *Anderson* is a new reference and was never previously relied upon by the examiner.

Apparently, the examiner re-examined the claim language from the December 15, 2003 amendment for Claim 17 and ignored the June 1, 2004 amendment to Claim 17 as evidenced by the examiner's statement "Applicant has amended claims 1, 17 in the amendment filed on 12/15/03 in the first sentence of

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the September 13, 2004 office action. The examiner further emphasized the exact claim language considered on pages 7 and 17 of the September 13, 2004 office action by stating “*Anderson* does not clearly teach the claimed limitation ‘a database automatically populated with existing customer data records without action taken by the customer’.” This claim language, properly amended on June 1, 2004, read “a database automatically populated with existing customer data records without registration action taken by the customer”. *See Amendment dated June 1, 2004* at 4.

The examiner clearly failed to consider the June 1, 2004 amendment in his finally rejection of Claim 17. From the record before the Appeals Board, Claim 17 has not been properly examined thus making any rejection of Claim 17 and the dependent claims of Group 2 improper. For this reason and because Claim 17 is non-obvious in view of all art of record, Applicant submits that all claims of Group 2 are allowable.

**Group 1 Prima facie Obviousness – Neither *Robertson* nor *Johnson* teaches or suggests the “without registration” and “non-registered” limitations**

The examiner finds some limitations of the claims of Group 1 in *Anderson*, but readily admits that *Anderson* does not teach or suggest “receiving records of individuals from an existing database automatically and without registration by the individuals; populating a web-based database with the individual records of the non-registered individual”. **Office Action dated September 13, 2004** at 2-3 and 16. The

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examiner relies on *Robertson* or *Johnson* to teach these additional limitations.

Neither of these prior art references bridges the gap between *Anderson* and Applicant's claimed invention.

**Group 1 – Anderson in view of Robertson**

*Robertson* fails to bridge the gap between *Anderson* and applicant's claimed invention because the invention in *Robertson* requires a user to register before it can automatically update information between databases. Examiner points out that *Robertson* teaches the following:

The personal address book of the first user contains the information in the data fields that the second users have given the first user permission to view. Whenever a second user changes any information in any data field of his data record, the information in that field is automatically updated in the information database of each first user whom he has given permission to view the information in that data field.

**Office Action Dated September 13, 2004** at 3. The examiner fails to appreciate that in order for the invention taught by *Robertson* to function as described; both the first user and second user must have already registered and defined permissions for access to their information. *Robertson* discloses "the member associates himself with any number of affinity groups and creates a data record for himself". [col. 2, lines 58-60]. Applicant, realizing *Robertson* requires registration, previously amended Claim 1 on June 1, 2004 to explicitly require the reception of data "**automatically and without registration**". *Robertson* fails to

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bridge the gap between *Anderson* and the claims of Group 1 that teach “receiving records of individuals from an existing database *automatically and without registration by the individuals*; populating a web-based database with the individual records of the *non-registered* individuals.”

*Robertson* not only fails to teach “receiving records... automatically and without registration” but actually teaches away from this limitation. *Robertson* clearly discloses and the examiner readily recognizes that the second user must give the first user permission to view the data. **Office Action Dated September 13, 2004** at 3; citing *Robertson* col. 3, lines 10-25. This is not possible without both the first user and second user registering and thus does not meet the limitations of the claims of Group 1. The *Robertson* reference clearly teaches away from “Receiving records... automatically and without registration”.

Furthermore, the modification and combination of *Anderson* and *Robertson* to function “automatically and without registration” proposed by the examiner renders the prior art unsatisfactory for its intended purpose, and thus there is no suggestion or motivation to make the proposed modification. The modification proposed by the examiner would change the principle of operation of both *Robertson* and *Anderson* because neither invention functions without registration. Thus, the teachings of the *Anderson* and *Robertson* are not sufficient to render the claims *prima facie* obvious on this ground.

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Without improperly and fundamentally changing the inventions disclosed in *Anderson* and *Robertson*, the examiner's reference of *Anderson* combined with *Robertson* is insufficient to render the claims of Group 1 *prima facie* obvious because all the limitations found in the claims of Group 1 are not taught by *Anderson* in view of *Robertson*. The examiner readily admits that all the limitations of the claims in Group 1 are not taught by *Anderson* alone and *Robertson* does not bridge the gap between *Anderson* and the claimed invention.

**Group 1 – Anderson in view of Johnson**

*Anderson* in view of *Johnson* fails to render the claims of Group 1 *prima facie* obvious in the same manner as *Anderson* in view of *Robertson*. The examiner again readily admits that *Anderson* does not teach the claimed limitation "receiving records of individuals from an existing database automatically and without registration by the individuals; populating a web-based database with the individual records of the non-registered individual" but this time relies upon *Johnson* to bridge the gap. **Action dated September 13, 2004 at 16-17.** *Johnson* fails to bridge the gap between *Anderson* and the invention claimed in Group 1.

Applicant's invention claimed in Group 1 discloses receiving records of individuals... automatically and without registration" and "populating a web-based database with the individual records of the non-registered individual". *Johnson*, in contrast, teaches a medical network of computer servers wherein the server

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computers “store medical record documents and data for each patient of each subscribing provider”. [col. 4, lines 54-55]. Reading the *Johnson* disclosure as a whole, *Johnson* requires that the individuals register with the provider who is also registered before the data in question will ever become part of the system described in *Johnson*. One example in *Johnson* only allows “access by other authorized providers and subscribers to the system” [col. 2, line 55]. This is fundamentally different than the Group 1 claimed invention requiring receiving records “automatically and without registration” for a “non-registered individual”.

The *Johnson* reference not only fails to teach “receiving records... automatically and without registration” for a “non-registered individual” limitation but actually teaches away from this limitation. *Johnson* teaches a “database is automatically populated using information extracted from certain documents such as an admission or *registration* document.” [col. 3, lines 18-20]. It is axiomatic for the examiner to point to *Johnson* to teach “automatically and without registration” for a “non-registered individual” when the disclosure clearly teaches the use of registration documents. *Johnson* further teaches away from “automatically and without registration” and discloses that the providers are “authorized” or actual “subscribers” [col. 2, line 55]. Additionally, a system for medical records implicitly requires that the patient register with the provider or subscriber because of the privileges involved

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with medical records. The system disclosed by *Johnson* requires at least two separate registration steps and clearly teaches away from the invention claimed in Group 1.

Furthermore, the modification of *Anderson* in view of *Johnson* to function “automatically and without registration” proposed by the examiner would render *Johnson* unsatisfactory for its intended purpose, and thus there is no suggestion or motivation to make the proposed modification. Modifying the invention disclosed by *Johnson* to function “automatically and without registration” for a “non-registered individual” would change the principle of operation of the prior art invention being modified because *Johnson* clearly requires registered users. As noted supra, *Johnson* teaches the use of registration documents. Without fundamentally changing the invention disclosed in *Johnson*, *Anderson* combined with *Johnson* is not sufficient to render the claims of Group 1 *prima facie* obvious because the limitation “automatically and without registration” for a “non-registered user” is not taught or suggested by any art of record including *Anderson* in view of *Johnson*.

### **Conclusion, Group 1**

The examiner has failed to make a *prima facie* showing of obviousness of the claims of Group 1 because *Anderson* cannot be properly combined with either *Robertson* or *Johnson*. Furthermore, *Anderson* in view of *Robertson* or *Johnson* fails to teach all limitations of the claims even if these references can be properly combined. In addition, both *Robertson* and *Johnson* teach away from the claimed

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limitations "automatically and without registration" and "non-registered individual".

For at least these reasons, the claims in Group 1 are non-obvious and should be allowed.

**Group 2 Prima facie Obviousness – Neither *Robertson* nor *Johnson* teaches or suggests the "without registration" and "non-registered" limitations**

Applicant believes examiner failed to properly examine Claim 17 and thus the claims of Group 2. Subject to this assertion, Applicant will demonstrate the patentability of Claim 17 and the claims of Group 2 as amended on June 1, 2004 and listed herein.

The examiner finds some limitations of the claims of Group 2 in *Anderson*, but presumably admits that *Anderson* does not teach or suggest "a database automatically populated with existing customer data records without registration by the customer". The examiner then exclusively relies on *Robertson* or *Johnson* to teach this additional limitation. Neither of these prior art references bridges the gap between *Anderson* and Applicant's invention because neither suggests that the customer had not been previously registered in each system.

**Group 2 – *Anderson* in view of *Robertson***

*Robertson* fails to bridge the gap between *Anderson* and Applicant's invention because the invention in *Robertson* requires a user to register before it can automatically update information between databases. Examiner points out that *Robertson* teaches the following:

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The personal address book of the first user contains the information in the data fields that the second users have given the first user permission to view. Whenever a second user changes any information in any data field of his data record, the information in that field is automatically updated in the information database of each first user whom he has given permission to view the information in that data field.

**Office Action Dated September 13, 2004** at 7. The examiner fails to appreciate that in order for the invention taught by *Robertson* to function as described; both the first user and second user must have already registered and set permissions for access to their information. *Robertson* also discloses the following:

When a user becomes a member of the system, the member associates himself with any number of affinity groups and creates a data record for himself by entering information in specific data fields. Based on the affinity groups with which the user has associated himself, the system then informs the user of other members in the same groups and allows the user to establish a link to any of those members on an individual basis. [col. 2, lines 58-65].

The above disclosure clearly indicates *Robertson*'s teaching that each individual must register or "associate" himself. Applicant previously amended Claim 17 on June 1, 2004 to explicitly require automatic population "without registration". *Robertson* does not disclose the as-amended limitation of the claims of Group 2 requiring "a database *automatically* populated with existing customer data records *without registration* by the customer".

*Robertson* not only fails to teach "automatically populated with existing customer data records *without registration*" limitation but actually teaches away from this limitation. *Robertson* clearly discloses and the examiner readily recognizes

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that the second user must give the first user permission to view the data. [col. 3, lines 14-16]; *see also* Office Action Dated September 13, 2004 at 7. It is implicit that the second user can only give the first user permission if they are both registered. This is contrary to the limitation in the claims of Group 2 requiring “automatic populat[ion] with existing customer data records without action registration by the customer”. Thus, *Robertson* manifestly teaches away from the limitation “automatically populated with existing customer data records without registration”.

Furthermore, the modification of *Anderson* in view of *Robertson* to populate data “without action taken by the customer” would render *Robertson* unsatisfactory for its intended purpose, and thus there is no suggestion or motivation to make the proposed modification. The invention disclosed by *Robertson* intends to allow a first user to share information with a second user. The modification proposed by the examiner for *Robertson* to function “without registration by the customer” and “distributing the access numbers to the unregistered customer” changes the principle of operation of the both *Anderson* and *Robertson*. Without fundamentally changing the invention disclosed in *Anderson* and/or *Robertson*, *Anderson* combined with *Robertson* is insufficient to render the claims of Group 2 *prima facie* obvious because all the limitations found in the claims of Group 2 are not taught by *Anderson* in view of *Robertson*.

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**Group 2 – Anderson in view of Johnson**

*Anderson* in view of *Johnson* likewise fails to render the claims of Group 2 *prima facie* obvious. The examiner again readily admits that *Anderson* does not teach the claimed limitations “a database automatically populated with existing customer data records without action taken by the customer” but alternatively relies upon *Johnson* to render the invention claimed as obvious. See September 13, 2004 Office Action at 17. *Johnson* fails to support the conclusion reached that makes obvious the invention claimed in Group 2.

Applicant’s invention claimed in Group 2 discloses automatically populating a database “with existing customer data records automatically and without registration by the customer”. *Johnson*, in contrast, teaches a medical network of computer servers wherein the server computers “store medical record documents and data for each patient of each subscribing provider”. [col. 4, lines 54-55]. Reading the *Johnson* disclosure as a whole, *Johnson* requires that the individuals register with the “authorized provider” who is also registered before the data in question will ever become part of the system described in *Johnson*. [col 2, line 55]. *Johnson* further discloses the use of a “registration document” for a “new patient record”. [col. 12, lines 44-45]. This is fundamentally different than the Group 2 claimed invention requiring receiving records “automatically and without registration”.

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The *Johnson* reference not only fails to teach “automatically populated... without registration” for an “unregistered customer” limitations but actually teaches away from these limitations. *Johnson* clearly discloses that the providers are “authorized” or actual “subscribers” [col. 2, line 55] and further discloses the use of “registration documents” for “new patients”. [col. 12, lines 44-45]. Additionally, it is implicit that a system for medical records requires that the patient register with the provider or subscriber. *Johnson* requires at least two separate registration steps and clearly teaches away from the invention claimed in Group 2 requiring automatic population “without registration”.

Furthermore, the modification of *Anderson* and/or *Johnson* to function “without registration” for “unregistered customers” would render at least *Johnson* unsatisfactory for its intended purpose, and thus there is no suggestion or motivation to make the proposed modification. Furthermore, the modification would change the principle of operation of the prior art invention being modified, and thus the teachings of *Anderson* in view of *Johnson* are not sufficient to render the claims of Group 2 *prima facie* obvious.

### **Conclusion, Group 2**

The examiner again failed to make a *prima facie* showing of obviousness of the claims of Group 2 because *Anderson* cannot be properly combined with either *Robertson* or *Johnson*. Furthermore, *Anderson* in view of *Robertson* or *Johnson* fails

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to teach all limitations of the claims even if these references can be properly combined. In addition, both *Robertson* and *Johnson* teach away from the claimed limitation "without registration". For at least these reasons, the claims in Group 2 are non-obvious and should be allowed.

**Applicant's invention was not obvious based on Knowledge of One of Ordinary Skill in the Art**

The mere fact that a reference can be modified is not sufficient to establish a *prima facie* case of obviousness. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); MPEP 2143.01. To support the conclusion that the claimed invention is directed toward obvious subject matter, the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). MPEP 2142.

Examiner has presented no such line of reasoning and none exists. All the references relied upon by examiner (*Anderson*, *Johnson*, and *Roberts*) are clearly contrary to Applicant's invention that requires the data to transfer automatically and "without registration". Considering the purpose of each of the cited prior art references as a whole, it would not have been obvious to one of ordinary skill in the art to modify the prior art to function automatically and "without registration" as claimed by Applicant in both Groups 1 and 2.

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**9. CONCLUSION**

It is respectfully submitted that there is no *prima facie* case of obviousness from the cited references and that the claims are directed to a meritorious advance of the art, deserving of patentability. It is respectfully submitted that the rejection of claims 1-12 (Group 1) and 17-23 (Group 2) was improper and should be reversed.

Respectfully submitted,



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## 10. APPENDIX

A clean copy of the claims involved in the appeal is as follows:

1. (rejected) A method of automatically populating, maintaining and updating a web-based database, the method comprising the steps of:
  - (a) receiving records of individuals from an existing database automatically and without registration by the individuals;
  - (b) populating a web-based database with the individual records of the non-registered individuals;
  - (c) creating an access account for each individual record;
  - (d) transmitting the access account to the non-registered individuals; and
  - (e) enabling remote maintenance of the individual records by use of the access account.
2. (rejected) The method of claim 1, wherein the records are received by transfer across an electronic link.
3. (rejected) The method of claim 2, wherein the electronic link is electronic mail.
4. (rejected) The method of claim 2, wherein the electronic link is selected from satellite systems, cable systems, direct modem connections, network connections, VPN connections, or Intranet connections.
5. (rejected) The method of claim 1, wherein the populating of the web-based database with the individual records further comprises automatically mapping the records.
6. (rejected) The method of claim 1, wherein the populating of the web-

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based database with the individual records further comprises manually mapping the records.

7. (rejected) The method of claim 1, wherein the access accounts are generated automatically.
8. (rejected) The method of claim 1, wherein the temporary access accounts are transmitted to the individuals by fax.
9. (rejected) The method of claim 1, wherein the temporary access accounts are transmitted to the individuals by email.
- 10.(rejected) The method of claim 1, wherein the temporary access accounts are transmitted to the individuals by a media selected from voice mail, physical address, or pager.
- 11.(rejected) The method of claim 1, wherein the remote maintenance occurs across the Internet.
- 12.(rejected) The method of claim 1, wherein the remote maintenance comprises altering the individual records.
- 13.– 16. (cancelled)
- 17.(rejected) A remotely accessible data storage system, comprising:
  - (a) a database automatically populated with existing customer data records without registration by the customer;
  - (b) an account generator provided for creating access numbers for the customer data records;

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(c) a broadcast system provided for distributing the access numbers to the unregistered customer; and

(d) an update system provided to enable customer access to the data records by use of the access numbers.

18. (rejected) The remotely accessible data storage system of claim 17, wherein the database is a web-based database.

19.(rejected) The remotely accessible data storage system of claim 17, wherein the customer data records include marketing profiles.

20.(rejected) The remotely accessible data storage system of claim 17, wherein the broadcast system distributes the access numbers by facsimile.

21.(rejected) The remotely accessible data storage system of claim 17, wherein the broadcast system distributes the access numbers by email.

22. (rejected) The remotely accessible data storage system of claim 17, wherein the broadcast system distributes the access numbers by the media selected from voice mail, instant messaging, mail, or by pager.

23.(rejected) The remotely accessible data storage system of claim 17, wherein the broadcast system distributes the access numbers by a combination of fax, email, and voice mail.

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**11. ATTACHMENTS**

Please find attached a copy of each reference cited:

1. B. *Anderson* et al., U.S. Patent No. 6,144,959.
2. B.D. *Robertson*, U.S. Patent No. 6,269,369 B1.
3. G.D. *Johnson* et al., U.S. Patent No. 5,664,109.